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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,806	08/28/2001	Naohisa Suzuki	862.C2338	2957

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EXAMINER

MASON, DONNA K

ART UNIT PAPER NUMBER

2111

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/939,806

Applicant(s)

SUZUKI ET AL.

Examiner

Donna K. Mason

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/06/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,815,678 to Hoffman, et al. ("Hoffman").

With regard to claim 1, 5, 8, 12, 15, and 16, Hoffman discloses an information processing apparatus, method, and computer program product, the apparatus including: an interface (Fig. 2, item 212) arranged to connect to a serial bus compatible to or complying with the IEEE 1394 standard (Fig. 2, item 214); and a memory (Fig. 2, item 208) arranged to store, in a predetermined first address area, configuration ROM information complying with the IEEE 1212 standard, and to store configuration information identical to the configuration ROM information in an a second address area different from the predetermined first address area (column 4, lines 42-46 and column 7, lines 47-50). Hoffman further discloses a computer program product including a

computer readable medium storing a computer program code (*see generally*, Fig. 2, item 208 or 210).

With regard to claims 2-4, 6, 7, 9-11, 13, and 14, Hoffman discloses the apparatus, method, and computer program product where the configuration ROM information contains information used to refer to the second address area where the configuration information is stored; where the configuration ROM information has a general format defined in the IEEE 1212 standard, and the first entry in the root directory of the configuration ROM information contains information used to refer to the second address area where the configuration information is stored; and where the second address area where the configuration information is to be stored is an area where a block read transaction with a large block size is supported (*see generally*, column 7, lines 32-62; Figs. 10 and 11; column 8, lines 27-67 to column 10, 1-5).

Therefore, Hoffman reads on the invention as specified in claims 1-16.

3. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,671,768 to Brown.

With regard to claim 1, 5, 8, and 12, Brown discloses an information processing apparatus and method, the apparatus including: an interface (Fig. 3A, item 18a) arranged to connect to a serial bus compatible to or complying with the IEEE 1394 standard (Fig. 3A, item 22; column 7, lines 36-40); and a memory (Fig. 3A, item 26) arranged to store, in a predetermined first address area, configuration ROM information complying with the IEEE 1212 standard, and to store configuration information identical

to the configuration ROM information in an a second address area different from the predetermined first address area (Fig. 3A, items 12a and 12b; column 3, lines 41-45).

With regard to claims 2-4, 6, 7, 9-11, 13, and 14, Hoffman discloses the apparatus and method where the configuration ROM information contains information used to refer to the second address area where the configuration information is stored; where the configuration ROM information has a general format defined in the IEEE 1212 standard, and the first entry in the root directory of the configuration ROM information contains information used to refer to the second address area where the configuration information is stored; and where the second address area where the configuration information is to be stored is an area where a block read transaction with a large block size is supported (*see generally*, column 1, lines 34-67 to column 2, lines 1-55).

Therefore, Brown reads on the invention as specified in claims 1-14.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,842 to Takayama in view of U.S. Patent No. 6,553,432 to Critz, et al. ("Critz").

With regard to claims 1, 5, 8, 12, 15, and 16, Takayama discloses an information processing apparatus and method, the apparatus including an interface (Fig. 7, item 5) arranged to connect to a serial bus (Fig. 7, item 13) compatible to or complying with the IEEE 1394 standard; and a memory (Fig. 7, items 8 and 9) arranged to store, in a predetermined address area, configuration ROM information complying with the IEEE 1212 standard (see column 4, lines 23-31) and to store configuration information in an address area different from the predetermined address area (column 10, lines 20-23).

With further regard to claims 5, 12, and 16, it should be noted that although Takayama does not expressly disclose a minimal format and a general format complying with the IEEE 1212 standard, this feature is deemed to be inherent. For example, as disclosed in U.S. Patent No. 6,671,768 to Brown, "in IEEE Standard 1394, two configuration ROM formats are supported: minimal and general" (Brown, column 1, lines 37-38). As discussed in Brown, these configuration ROM implementations are well known in the field of serial bus devices (Brown, column 1, lines 34-37).

With regard to claims 2-4, 6, 7, 9-11, 13, and 14, Takayama discloses the apparatus, method, and computer program product where the configuration ROM information contains information used to refer to the second address area where the configuration information is stored; where the configuration ROM information has a general format defined in the IEEE 1212 standard, and the first entry in the root directory of the configuration ROM information contains information used to refer to the second address area where the configuration information is stored; and where the second address area where the configuration information is to be stored is an area

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where a block read transaction with a large block size is supported (see *generally*, column 4, lines 23-67 to column 6 lines 1-46).

Takayama does not expressly disclose where the configuration information stored in the second address area is identical to the configuration information stored in the first address area, as recited in claims 1, 5, 8, 12, 15, and 16. Takayama also does not expressly disclose a computer program product including a computer readable medium storing computer program code, as recited in claims 15 and 16.

Critz discloses where the configuration information stored in the second address area is identical to the configuration information stored in the first address area (column 2, lines 15-28) and a computer program product including a computer readable medium storing computer program code (Fig. 1, item 110). As recited in column 2, lines 20-21, a series of events results in the shadowing of the BIOS from permanent storage into RAM.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art combine Critz with Takayama, to the configuration information stored in the first address area in a second address area. The suggestion or motivation for doing so would have been because RAM is faster than ROM. Therefore, many computer manufacturers design systems so that the BIOS is copied from ROM to RAM each time the computer is booted. This technique, known as "shadowing," is well known in the art.

Therefore, it would have been obvious to combine Critz with Takayama to obtain the invention as specified in claims 1-16.

### ***Response to Arguments***

6. Applicant's arguments, see pages 9-12, filed August 6, 2004, with respect to the rejections of claims 1-14 under 35 USC 102(b) and claims 15-16 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, new grounds of rejection are made in view of Hoffman, Brown, and Takayama in view of Critz.

The Examiner is persuaded that Takayama does not expressly disclose where the configuration information stored in the second address area is identical to the configuration information stored in the first address area. Nonetheless, Hoffman, Brown, and Critz each teach this feature.

### ***Conclusion***

A shortened statutory period for reply is set to expire THREE MONTHS from the mailing date of this communication. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna K. Mason whose telephone number is (571) 272-3629. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on (571) 272-3632. The fax phone




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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKM



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